

REMARKS

Claim 20 has been added. Support can be found in the original claims, for example. Claims 15-19 have been withdrawn from further consideration as being directed to a non-elected invention. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Affirmation of Election

Applicant hereby affirms that the invention I, product claims 6-14, is elected for further prosecution without traverse. However, Applicant reserves the right to rejoin the non-elected process claims, provided that all the limitations of an allowable product claim are timely recited in the process claims.

Rejections of Claims 6-8 Under 35 U.S.C. § 102

Claims 6-8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Klyosov et al (5,919,424).

The Office Action states: "Klyosov teaches a papermaking sludge ... Klyosov teaches a paper, which is seen as functioning as a newsprint paper for offset printing since the same material and structure is taught, see MPEP2111.02. Without such reliance, however, a preamble is generally not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention." *Office Action* at page 4, the fifth to last line to page 5, line 6.

However, claim 6 recites:

A newsprint paper for offset printing comprising a base paper containing a filler or fillers in an amount of more than 15 percent by weight but less than 40 percent by weight as ash relative to the dry weight of the base paper.

The "newsprint paper" is a specific type of paper and structurally distinguishable from other types of paper. For example, "Newsprint is low-cost, non-archival paper most commonly used to print newspapers, plus other publications and advertising material. It usually has an off-white cast and distinctive feel. It is designed for use on printing presses that employ a long web of paper (web offset, letterpress and flexographic) rather than individual sheets of paper."

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Newsprint - Wikipedia (<http://en.wikipedia.org/wiki/Newsprint>, accessed 11/18/2008). Thus, in claim 6, the claim body does not describe a structurally complete invention, and the "newsprint paper" should be considered as subject matter claimed in claim 6.

Furthermore, in the claim body of claim 6, "a base paper" is recited. The "base paper" is not a papermaking sludge. The base paper is structurally and functionally dissimilar to a papermaking sludge. Klyosov itself states: "Pulp and paper sludge (a byproduct of primary pulping operations, recycle streams or waste paper pulping and the like), as well as the products of its incineration, represent an environmental and disposal problem for manufacturers of pulp and paper." *Klyosov* at col. 1, lines 13-17. There is no support in *Klyosov* for the proposition that a papermaking sludge can be a base paper. It is not a reasonable claim interpretation to equate "base paper" with "papermaking sludge." *Klyosov* does not teach or suggest a newsprint paper or base paper, and therefore, claim 6 cannot be anticipated by *Klyosov*. Claims 7-8 also cannot be anticipated by *Klyosov* at least due to their dependencies upon claim 6.

It is respectfully requested that the rejections be withdrawn.

Rejections of Claims 9-12 Under 35 U.S.C. § 103

Claims 9-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Klyosov et al* in view of *Munchow* (6,214,166).

As discussed above in relation to claim 1, *Klyosov* teaches a papermaking sludge, not a paper. *Klyosov* states: "Generally, pulp and paper sludge is unsuitable for paper making, although it generally includes the same components-lignin, cellulose, hemicellulose, calcium carbonate, clay, and other inorganic components-as those present in the paper pulp itself." *Klyosov* at col. 1, lines 17-21. *Klyosov* published a book and states:

Pulp and paper sludge (a by-product of primary pulping operations, recycle streams, or waste paper pulping and the like) represents an environmental and disposal problem for manufacturers of pulp and paper. Generally, pulp and paper sludge is unsuitable for paper making, although it generally contains the same components - cellulose, lignin, hemicelluloses, calcium carbonate, clay, and other inorganic components - as those present in the paper pulp itself. The main reason why papermaking sludge is unsuitable to bring it back for paper making is that it contains predominantly short cellulose fiber, which decreases the quality of paper.

Wood-Plastic Composites - Google Books Result, by Anatole A. Klyosov - 2007 -Technology & Engineering, page 111, the first paragraph under "PAPERMAKING SLUDGE". A papermaking

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sludge is not used for paper making because "it contains predominantly short cellulose fiber, which decreases the quality of paper." This is because a papermaking sludge is a waste from which pulp has been already taken out. A paper could not be produced from a papermaking sludge. A skilled artisan would not learn from Klyosov to produce a paper from a papermaking sludge. Also, Klyosov does not provide enabling disclosure to produce a paper from a papermaking sludge. Klyosov does not teach or suggest, in any predictable manner, "a base paper containing a filler or fillers in an amount of more than 15 percent by weight but less than 40 percent by weight as ash relative to the dry weight of the base paper" as defined in claim 6.

Munchow does not supply the deficiencies of Klyosov.

Therefore, claim 6 could not be obvious over Klyosov and Munchow. Claims 9-12 also could not be obvious over Klyosov and Munchow at least due to their dependencies upon claim 6.

It is respectfully requested that the rejections be withdrawn.

Rejections of Claims 13-14 Under 35 U.S.C. § 103

Claims 13-14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Klyosov et al in view of Hirabayashi et al (6,458,413).

As discussed above in relation to claim 6, claim 6 could not be obvious over Klyosov and further in view of Munchow. Hirabayashi et al does not supply the deficiencies of Klyosov and Munchow. Therefore, claim 6 could not be obvious over Klyosov and Hirabayashi et al.

It is respectfully requested that the rejections be withdrawn at least due to the dependency of claims 13-14 upon claim 6.

Claims 13-14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Klyosov et al in view of Hirabayashi et al and Maruyama et al (5,527,852).

As discussed above in relation to claim 6, claim 6 could not be obvious over Klyosov and Hirabayashi et al. Maruyama et al does not supply the deficiencies of Klyosov and Hirabayashi et al. Therefore, claim 6 could not be obvious over Klyosov and Maruyama et al.

It is respectfully requested that the rejections be withdrawn at least due to the dependency of claims 13-14 upon claim 6.

New Claim

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Claim 20 has been added. Claim 20 recites both an average grain size of 0.5 to 5 μm and a zeta potential of 0 mV or above due to its dependency upon claim 9. This feature is not taught or suggested by the prior art of record.

CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. The grounds for rejection which are not discussed herein are moot and Applicants expressly do not acquiesce in the findings not separately addressed. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

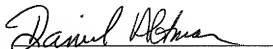
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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